

REMARKS

Claims 1-3 and 6-19 are pending in this application after this Amendment. Claims 1 and 11 are independent. Claims 17-19 have been added. In light of the amendments and remarks made herein, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner rejected claim 1 under 35 U.S.C. § 102(e) as being anticipated by *Ryne et al.* (USP 6,389,924); and rejected claims 2, 7, 11, 12, and 16 under 35 U.S.C. § 103(a) as being unpatentable over *Ryne et al.* Applicant respectfully traverses these rejections.

Applicant wishes to thank the Examiner for indicating that claims 3, 6, 8-10, and 13-15 contain allowable subject matter.

Claim Rejections - 35 U.S.C. § 102

By this Amendment, Applicants have amended claim 1 to more appropriately recite the present invention. It is respectfully submitted that this amendment is being made without conceding the propriety of the Examiner's rejection, but merely to timely advance prosecution of the present application.

In support of the Examiner's rejection of claim 1, and in response to Applicant's arguments included in the Reply filed on October 22, 2003, the Examiner asserts it would be clear that the structure disclosed in *Ryne et al.* would operate and function in the claimed manner. The Examiner additionally asserts that the

connection is meant to be disconnected upon force or impact. Applicant respectfully disagrees with the Examiner's characterization of this reference.

As Applicant previously asserted in the Reply filed on October 22, 2003, *Ryne et al.* merely discloses the column mounted electric power assist apparatus 12 includes a structural housing 26 and an electric motor 28 rigidly attached to the housing at a mounting flange 30. While the Examiner notes that the connection is meant to be disconnected upon force or impact, it is well-settled that a rejection under 35 U.S.C. § 102 is not proper based upon the present facts. See, for example, *Continental Can Co. U.S.A., Inc. v. Monsanto*, 20 USPQ2d 1746, 1749, 1750 (Fed. Cir. 1991), which stated as follows:

Inherency ... may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient....

While the Examiner is inferring that it is inherent that the connection would be disconnected upon force or impact, Applicant notes that it is merely possible that *Ryne et al.* teaches flange 30 to facilitate assembly or disassembly. As such, Applicant submits that it is not inherent that the connection would be disconnected upon force or impact and that based upon Applicant's submission of an alternate purpose for the Examiner's explanation of the structure disclosed in *Ryne et al.*, it is respectfully submitted

that it is not inherent that *Ryne et al.* teaches or suggests the claimed element.

By this Amendment, Applicant has amended claim 1 to recite, *inter alia*, an electric power steering apparatus wherein the supporting mechanism has an impact releasing mechanism configured to release support of the motor on the stationary member when impact energy is applied to the motor. As *Ryne et al.* fails to teach or suggest this element, and, further, as it is not inherent that *Ryne et al.*'s structure teaches or suggests this element, it is respectfully submitted that claim 1 is not anticipated under 35 U.S.C. § 102. As such, it is respectfully requested that the outstanding rejection be withdrawn.

It is further respectfully submitted that claims 2-3, 6-10, and 12-13 are allowable for the reasons set forth above with regard to claim 1 at least based upon their dependency on claim 1.

Claim Rejections - 35 U.S.C. § 103

By this Amendment, Applicant has amended claim 11 to more appropriately recite the present invention. For example, claim 11 recites, *inter alia*, an electric power steering apparatus comprising an arc-shaped groove provided in the shaft housing, the arc-shaped groove being open to the interior of the shaft housing opening and having a discontinuity into which the projection is inserted so as to be movable in a length direction of the groove. While *Ryne et al.* discloses a steering column for a motor vehicle,

the column including structural housing 12 and an electric motor 28 rigidly attached to the housing and mounting flange 30, there is no teaching or suggestion in *Ryne et al.* that is directed to an arc-shaped groove provided in the shaft housing, the arc-shaped groove being open to the interior of the shaft housing opening and having a discontinuity into which the projection is inserted so as to be movable in a length direction of the groove. As *Ryne et al.* fails to teach or suggest all of the claimed elements of claim 11, as amended, it is respectfully submitted that claim 11 is not obvious over *Ryne et al.* It is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 16-19 are allowable for the reasons set forth above with regard to claim 11 based upon their dependency on claim 11.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees


required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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